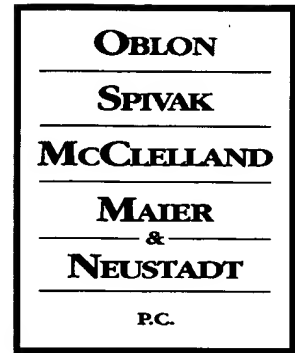




Docket No.: 275735US6PCT

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313



ATTORNEYS AT LAW

RE: Application Serial No.: 09/913,586  
Applicants: Toshihiro MORITA, et al.  
Filing Date: August 15, 2001  
For: INFORMATION PROCESSING APPARATUS AND  
METHOD, AND PROGRAM STORAGE MEDIUM  
Group Art Unit: 2155  
Examiner: VITALI A. KOROBV

SIR:

Attached hereto for filing are the following papers:

**PETITION UNDER 37 C.F.R. § 1.181 TO ACCOMPANY RESPONSE TO REQUIREMENT  
FOR INFORMATION UNDER 37 C.F.R. § 1.105**

**RESPONSE TO REQUIREMENT FOR INFORMATION UNDER 37 C.F.R. § 1.105**

Our check in the amount of - is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

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DOCKET NO: 275735US6PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :  
TOSHIHIRO MORITA, ET AL. : EXAMINER: VITALI A. KOROBV  
SERIAL NO: 09/913,586 :  
FILED: AUGUST 15, 2001 : GROUP ART UNIT: 2155  
FOR: INFORMATION PROCESSING :  
APPARATUS AND METHOD, AND  
PROGRAM STORAGE MEDIUM

PETITION UNDER 37 C.F.R. § 1.181 TO ACCOMPANY  
RESPONSE TO REQUIREMENT FOR INFORMATION UNDER 37 C.F.R. § 1.105

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

SIR:

This Petition is in response to the Official Communication mailed on July 24, 2006.

This Petition under 37 C.F.R. § 1.181 requests that the requirement under 37 C.F.R. § 1.105, specifically items (A) and (F), be withdrawn as improper.

In the outstanding Official Communications, item (A) through (F) were requested to be responded to by the Applicants. In a response to this request for information, filed concurrently herewith, Applicants answered items (B) through (D) by stating that such information is unknown or not readily available to Applicants. Accordingly, Applicants respectfully submit that items (B) through (D) are fully satisfied by the Applicants' response. With respect to (E), Applicants have provided information with regard to this request, thus satisfying the Rule 105 request.

With regard to items (A) and (F), Applicants respectfully submit that the requests are improper under 37 C.F.R. § 1.105. Requests (A) and (F) are reproduced below.

A. Stipulate whether each and every individual cited reference listed on the IDS(s) submitted on 5/17/2006, 2/15/2006, 2/1/2006, 12/23/2005, 8/23/2005, 8/11/2003, and 8/15/2001 is material to the patentability of the instant application; the applicant may either agree or disagree for each cited reference.<sup>1</sup>

F. In order to constitute a complete response Applicant is required to include stipulations for each and every reference cited in the IDS submission(s) dated 5/17/2006, 2/15/2006, 2/1/2006, 12/23/2005, 8/23/2005, 8/11/2003 and 8/15/2001 as well as each and every IDS submission thereafter, as delineated in requirement A.<sup>2</sup>

Applicants note that, with regard to requests (A) and (F):

“Factual” and “facts” are included in 37 C.F.R. § 1.105 to make it clear that it is facts and factual information, that are known to Applicant, or readily obtained after reasonable inquiry by application, that are sought, and that requirements under 37 C.F.R. § 1.105 are not requesting opinions that may be held or would be required to be formulated by applicant. (emphasis added)<sup>3</sup>

Applicants note that 37 C.F.R. § 1.97(h) states that the filing of Information Disclosure Statement is not considered to be an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in 37 C.F.R. § 1.56. Information relative to the materiality of each reference is either unknown or not readily available to Applicants. The Examiner determines what is material, not Applicants, and thus, the Rule 105 improperly requests Applicants to express their opinion. Moreover, Applicants respectfully submit that they are not required to formulate such an opinion as noted above. Accordingly, Applicants respectfully submit that this request for information is improper.

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<sup>1</sup> Request for Information of July 24, 2006 at page 2.

<sup>2</sup> Request for Information of July 24, 2005 at paragraph bridging pages 3 and 4.

<sup>3</sup> See MPEP § 704.11

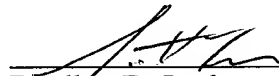
Rule 105 provides a mechanism by which the Examiner can make a factual inquiry. However, request (F) imposes a future duty on Applicants; and, as such, it is impossible for Applicants to presently comply with this request.

Therefore, it is submitted that the scope of the outstanding Request for Information under 37 C.F.R. § 1.105, at least with respect to requests (A) and (F), seek the formulation of an opinion, and/or seek to improperly impose a future duty, which is not required under 37 C.F.R. § 1.105.

Accordingly, it is respectfully submitted that this Petition Under 37 C.F.R. § 1.181 be granted and that the Examiner withdraw his requirement for information under 37 C.F.R. § 1.105 with respect to items (A) and (F).

Respectfully submitted,

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DOCKET NO: 275735US6PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :  
TOSHIHIRO MORITA, ET AL. : EXAMINER: VITALI A. KOROBV  
SERIAL NO: 09/913,586 :  
FILED: AUGUST 15, 2001 : GROUP ART UNIT: 2155  
FOR: INFORMATION PROCESSING :  
APPARATUS AND METHOD, AND  
PROGRAM STORAGE MEDIUM

RESPONSE TO REQUIREMENT FOR INFORMATION UNDER 37 C.F.R. § 1.105

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

SIR:

A Request for Information pursuant to 37 C.F.R. §1.105 was issued to Applicants on July 24, 2006. Below is a response to that request, which is made with candor and in good faith under 37 C.F.R. § 1.56.

A. Stipulate whether each and every individual cited reference listed on the IDS(s) submitted on 5/17/2006, 2/15/2006, 2/1/2006, 12/23/2005, 8/23/2005, 8/11/2003, and 8/15/2001 is material to the patentability of the instant application; the applicant may either agree or disagree for each cited reference.<sup>1</sup>

Applicants note that a proper request under 37 C.F.R. §1.105 is a request for factual information, which is reasonably necessary to properly examine or treat a matter in a pending

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<sup>1</sup> Request for Information of July 24, 2006 at page 2.

or abandoned application. A requirement for information under 37 C.F.R. § 1.105 places a substantial burden on the Applicants.<sup>2</sup> In this regard, the MPEP notes that:

“Factual” and “facts” are included in 37 C.F.R. § 1.105 to make it clear that it is facts and factual information, that are known to Applicant, or readily obtained after reasonable inquiry by application, that are sought, and that requirements under 37 C.F.R. § 1.105 are not requesting opinions that may be held or would be required to be formulated by applicant. (emphasis added)

Applicants note that 37 C.F.R. § 1.97(h) states that the filing of Information Disclosure Statement is not considered to be an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in 37 C.F.R. §1.56. The Examiner determines what is material, not Applicants; and, thus, the Rule 105 improperly requests Applicants to express their opinion. As information relative to the materiality of each reference is either unknown or not readily available to Applicants, and, Applicants are not required to formulate such an opinion as noted above, Applicants respectfully submit that this request for information is improper and/or satisfied by the representation above.<sup>3</sup>

1. Identify, for each and every citation listed on the IDS(s) submitted on 5/17/2006, 2/15/2006, 2/1/2006, 12/23/2005, 8/23/2005, 8/11/2003, and 8/15/2001, for which applicant agrees is material to the patentability.

a. The differences between the claimed invention and those references cited therein.<sup>4</sup>

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<sup>2</sup> MPEP § 704.11.

<sup>3</sup> See Petition concurrently filed under Rule § 1.181 as to the impropriety of this request.

<sup>4</sup> Request for Information of July 24, 2006 at page 3.

As noted above, this information is unknown, or not readily available. Likewise, as the formulation of such legal opinion or provision of such, if held, is an improper request under 37 C.F.R. §1.105, Applicants respectfully submit that this request is improper and/or satisfied by the above representation.

b. How each reference is material to the patentability, based upon the technical and legal knowledge of the Applicant, of the claimed invention,<sup>5</sup>

As noted above, this information is unknown, or not readily available. Likewise, as the formulation of such legal opinion or the provision of such, if held, is an improper request under 37 C.F.R. §1.105, Applicants respectfully submit that this request is improper and/or satisfied by the above representation.

c. Provide how the instant claimed invention is an improvement over each and every reference that is listed in the IDS submission(s) dated 5/17/2006, 2/15/2006, 2/1/2006, 12/23/2005, 8/23/2005, 8/11/2003, and 8/15/2001.<sup>6</sup>

As noted above, this information is unknown, or not readily available. Likewise, as the formulation of such legal opinion or the provision of such, if held, is an improper request under 37 C.F.R. §1.105, Applicants respectfully submit that this request is improper and/or satisfied by the above representation.

B. Provide a copy of any non-patent literature, published applications, or patent (US or Foreign) *used in drafting the instant application, whether cited or not* in the IDS

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<sup>5</sup> Request for Information of July 24, 2006 at page 3.

<sup>6</sup> Request for Information of July 24, 2006 at page 3.

submission(s) dated 5/17/2006, 2/15/2006, 2/1/2006, 12/23/2005, 8/23/2005, 8/11/2003, and 8/15/2001.<sup>7</sup>

Such information is unknown or not readily available to Applicants.

C. Provide a copy of any non-patent literature, published application, or patent (US or Foreign) *that was used in the inventive process to accomplish the applicant's inventive results.*<sup>8</sup>

Such information is unknown or not readily available to Applicants.

D. Provide the date of first use of the claimed invention, known by any of the inventors or Applicant, at the time the application was filed, *notwithstanding* the date of use.<sup>9</sup>

Such information is unknown or not readily available to Applicants.

E. Trademark(s) or Copyright(s) for the product(s) incorporating the instant claimed invention.<sup>10</sup>

Applicants market its products under various Sony trademarks and copyrights. Sony portable audio products are marketed at least under the Walkman<sup>®</sup> trademarks and associated copyrights, where appropriate. Sony<sup>®</sup> portable audio products and associated trademarks may be reviewed at [www.Sony.com](http://www.Sony.com).

F. In order to constitute a complete response Applicant is required to include stipulations for each and every reference cited in the IDS submission(s) dated 5/17/2006,

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<sup>7</sup> Request for Information of July 24, 2006 at page 3.

<sup>8</sup> Request for Information of July 24, 2006 at page 3.

<sup>9</sup> Request for Information of July 24, 2006 at page 3.

<sup>10</sup> Request for Information of July 24, 2006 at page 3.



2/15/2006, 2/1/2006, 12/23/2005, 8/23/2005, 8/11/2003 and 8/15/2001 as well as each and every IDS submission thereafter, as delineated in requirement A.<sup>11</sup>

As noted above, request "A" is either improper or satisfied, based upon the representations above.

Furthermore, Rule 105 provides a mechanism by which the Examiner can make a factual inquiry. However, request (F) imposes a future duty on Applicants; and, as such, it is impossible for Applicants to presently comply with this request.

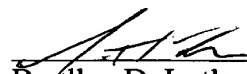
#### SUSPENSION OF THE ACTION

Applicants remind the U.S. Patent and Trademark Office that, upon receipt of this response to the Request for Information under 37 C.F.R. §1.105, **suspension of the prosecution in this case should be terminated immediately**, as the reason for initiating the suspension no longer exists, even though the suspension period has not expired.<sup>12</sup>

Accordingly, Applicants respectfully request that the suspension of prosecution in this Application be withdrawn.

Respectfully submitted,

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(OSMMN 06/04)

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Registration No. 42,866

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<sup>11</sup> Request for Information of July 24, 2005 at paragraph bridging pages 3 and 4.

<sup>12</sup> See MPEP § 709, page 700-141.